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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER NUMBER

1653  
DATE MAILED:

11  
02/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/220,691

Applicant(s)

TSUJI ET AL

Examiner

Jon P. Weber

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

*Status Of The Claims*

The response with amendments filed 07 December 2000 has been received and entered. Claims 1, 3-4 and 6-21 have now been presented for examination.

*Claim Rejections - 35 USC § 112*

Claims 1, 3-4 and 6-21 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is argued that matrix metalloproteinases (MMP) are a species of the genus of metalloproteinases which includes elastase-like and neutral endoproteinases as other species. It is urged that inhibitors of MMP does not mean inhibitors for metalloproteinases in general. It is urged that inhibitors of the entire genus of metalloproteinases are not disclosed by Tsuji et al.

The compounds disclosed by Tsuji et al. are within the scope of structures of the compounds in claim 7, being nearly the same in most respects. It is true that MMP are a species within the scope of the genus of metalloproteinases. However, no evidence is presented that the inhibitors of Tsuji et al. **only** inhibit MMP rather than metallo-proteinases.

The abstract of Tsuji et al. clearly states that their compounds are inhibitors of an elastin decomposing enzyme (i.e., elastase-like) belonging to the metal-dependent protease. Hence, contrary to the assertion in the response, the inhibitors in Tsuji et al. do inhibit metalloproteinases other than MMP.

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Accordingly the claims are not enabled for compounds of this structure which inhibit elastase-like and neutral metalloproteinases, but not MMP.

Applicant's arguments filed 07 December 2000 have been fully considered but they are not persuasive for the reasons of record and the additional reasons above.

***Claim Rejections - 35 USC § 102***

Claims 1, 3-4 and 6-21 stand provisionally rejected under 35 U.S.C. 102(a) as being anticipated by Tsuji et al. (JP 10265359) pending perfection of the instant Japanese priority document and a showing therein that the instantly claimed invention is adequately supported.

It is argued that the inhibitors of Tsuji et al. (JP 10265359) are matrix metalloprotease inhibitors and therefore excluded by the negative limitation in claim 1.

The teachings of Tsuji et al. (JP 10265359) have been discussed above. The structures are the same as set forth in instant claim 7. It is not understood how compounds of this structure could both be inhibitors of MMP in Tsuji et al. (JP 10265359) and yet not be inhibitors of MMP in the instant application. Clarification is requested.

Applicant's arguments filed 07 December 2000 have been fully considered but they are not persuasive for the reasons of record and the additional reasons above.

No claims are allowed.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

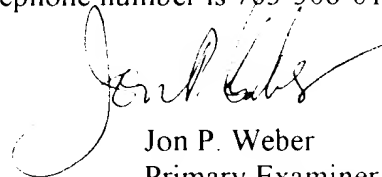
Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon P. Weber whose telephone number is 703-308-4015. The examiner can normally be reached on 1st Fri, 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Jon P. Weber  
Primary Examiner  
Art Unit 1651

JPW  
February 14, 2001